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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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The Mead Corporation

v.

Lisa Frank, Inc.

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Opposition No. 95,866  
to application Serial No. 74/470,350  
filed on December 16, 1993

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Cancellation No. 23,395

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J. Paul Williamson of Arnold, White & Durkee for The Mead  
Corporation

Harris J. Kane of Rosenfeld, Meyer & Susman for Lisa Frank,  
Inc.

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Before Seeherman, Hohein and Hairston, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

This proceeding involves both an opposition and cancellation action brought by The Mead Corporation (hereafter plaintiff).

Plaintiff has opposed the application of Lisa Frank, Inc. (hereafter defendant) to register RAINBOW REEF for "stationery-type portfolios, notebooks, writing tablets, memo pads and stickers."<sup>1</sup> As grounds for opposition, plaintiff has alleged that it manufactures, distributes and sells paper tablets under the mark RAINBOW; that it owns Registration No. 559,737 for RAINBOW for paper tablets; that plaintiff's use of RAINBOW for paper tablets predates the filing date of defendant's application; and that defendant's mark so resembles plaintiff's previously used and registered mark as to be likely, when used in connection with the goods of defendant, to cause confusion or mistake or to deceive.

Plaintiff has also petitioned to partially cancel defendant's registration for RAINBOW CHASER, with the word RAINBOW disclaimed.<sup>2</sup> Specifically, plaintiff seeks to cancel from the registration "notebooks, folders, binders and stationery." As grounds for cancellation, plaintiff alleges that it sells a wide variety of school and stationery products; that it has adopted and continuously

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<sup>1</sup> Application Serial No. 74/470,350, filed December 16, 1993, based on an asserted bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 1,846,209, issued July 19, 1994.

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used the mark RAINBOW from at least as early as 1916 in connection with the sale of paper tablets, which is well prior to the date of first use alleged by defendant and prior to the filing date of the application which matured into the registration which is the subject of this proceeding; that it owns Registration No. 559,737 for RAINBOW for paper tablets; and that defendant's mark RAINBOW CHASER so resembles plaintiff's previously used and registered mark RAINBOW that, when used in connection with notebooks, folders, binders and stationery, it is likely to cause confusion or mistake or to deceive.

In its answers defendant admitted the allegation in the petition to cancel that it has licensed the right to use the mark RAINBOW CHASER, and has denied the remaining salient allegations of both the notice of opposition and the petition to cancel. Defendant has also affirmatively asserted, in both of its pleadings, that there is no likelihood of confusion, and that plaintiff lacks standing.

On the stipulated motion of the parties, and because the cases involve common questions of law and fact, the Board consolidated the proceedings after answers had been filed. Accordingly, we will decide both cases on the same record and in a single opinion.

The record includes the pleadings; the files of the opposed application and the registration sought to be cancelled; the testimony, with exhibits, of plaintiff's witness Mark Davis and of defendant's witness Kenneth Enos.<sup>3</sup>

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<sup>3</sup> In its brief plaintiff has moved to strike certain testimony and exhibits defendant offered into evidence during the testimony deposition of Kenneth Enos. The basis for the objections is that defendant failed to provide this information in response to discovery requests served by plaintiff. Defendant has opposed the motion in its brief, and plaintiff has responded to defendant's arguments in its reply brief.

First, we note that, contrary to defendant's assertion, it is permissible for plaintiff to submit with its brief defendant's responses to plaintiff's discovery requests even though "such discovery responses are not included in Mead's Notice of Reliance and are not in evidence pursuant to Trademark Rule 2.122(e)." Defendant's brief, p. 6. (In fact, responses to document production requests may not be made of record pursuant to a notice of reliance.) Plaintiff has submitted these responses not as part of its evidentiary record, but in support of its motion to strike, and it is therefore acceptable to submit them as part of the brief which contains the motion.

We will not burden this opinion by a discussion of each of the many specific sections of testimony listed in plaintiff's Appendix 2. In general, plaintiff has moved to strike all references to defendant's evidence about references to its characters which were made in fan letters. However, plaintiff's discovery requests asked defendant to produce any documents which reflect any "studies, searches, or investigations" conducted at any time with respect to consumer acceptance of or reaction to the designation RAINBOW, RAINBOW CHASER or RAINBOW REEF, or any documents which reflect any "survey, research or other studies" done by defendant concerning the recognition level of consumers of RAINBOW CHASER or RAINBOW REEF. We do not regard defendant's keeping a tally of references to character names in the fan letters it receives as being a study, search, investigation, survey or research that would require defendant to produce a printout of this tally or the individual fan letters. Therefore, the motion to strike such testimony and related exhibits is denied.

Plaintiff has also moved to strike testimony relating to defendant's use of focus groups. We find focus groups as to whether, for example, RAINBOW CHASER appeals to children as a name for a horse character to constitute the type of study referred to in the document production requests, and therefore the motion to strike this testimony is granted. We would point out, however, that even if the testimony were considered it would have no impact on our decision, since Mr. Enos merely testified

that he was sure such focus group tests were conducted, but did not provide any information as to the results.

Plaintiff's motion to strike Mr. Enos' testimony with respect to, e.g., the geographic scope of sales of products bearing the mark RAINBOW CHASER or RAINBOW REEF, and the sales channels for the goods, is denied. Plaintiff's discovery requests do not ask for such information. However, Mr. Enos' testimony as to approximate unit volume of sales of such products is stricken, since plaintiff did request this information in its interrogatories, and defendant stated in response that it does not keep records of sales volume for particular designs. Even though defendant's attorney and its witness characterized the testimony as a rough approximation, defendant could have provided a good faith estimate during discovery.

Plaintiff's objection to Exhibit 12 (the current product list) is denied. Plaintiff requested that defendant produce "each different packaging or labelling" containing RAINBOW CHASER, RAINBOW REEF or the designation RAINBOW. Although plaintiff acknowledges that defendant "produced many products, the number of products ... produced fell far short of the number of products identified in ... Exhibit 12." Plaintiff has not supported its motion by providing us with the materials which were produced. More importantly, we do not read the document request as requiring defendant to produce one of each product that it sells, but merely each different type of labeling. From the products or product covers which have been made of record, it appears that the designs and other information is generally the same. Further, we note that defendant objected to the document production request as overbroad, burdensome and oppressive, and we agree that under such circumstances a party is required to provide only a representative sample.

Plaintiff has listed as a category of testimony to be stricken testimony as to defendant's advertising of its RAINBOW CHASER and RAINBOW REEF marks. However, the description in Appendix 2 of the specific lines of testimony sought to be stricken does not refer to advertising information, nor has plaintiff identified specific exhibits. Given the broad category of testimony to which plaintiff has objected, it would be unduly burdensome for the Board to attempt to ascertain the specific testimony and/or exhibits which plaintiff finds objectionable. Accordingly, we have not further considered this portion of the motion.

We would point out that whether all the objected-to evidence were considered or were excluded, it would not affect the outcome of our decision herein. Although the strength of a plaintiff's mark is a factor in determining likelihood of confusion, the strength of a defendant's mark does not have the same significance. The only impact of defendant's evidence with respect to advertising, sales and recognition of its marks would be in connection with the lack of evidence of actual confusion, i.e., if defendant could show substantial use of its mark along with plaintiff's use of its mark without any confusion, that would be a factor in showing that confusion is not likely to

Plaintiff has also relied on defendants' responses to certain of plaintiff's interrogatories; dictionary definitions of certain of the items listed in the identification of goods of defendant's application and registration; and a certified copy, showing status and title, of plaintiff's pleaded registration for RAINBOW, depicted in the stylized form shown below, for paper tablets<sup>4</sup>.

(IMAGE NOT AVAILABLE)

Defendant has made of record, under a notice of reliance, plaintiff's responses to certain of defendant's interrogatories.<sup>5</sup>

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occur. However, here defendant has used its marks for a relatively short period of time, such that we think the lack of evidence of actual confusion is entitled to relatively little weight. It is well known that evidence of actual confusion is notoriously difficult to obtain, and that is even more the case when the products are inexpensive.

Finally, the comments by both parties in connection with the motion to strike are, to say the least, acrimonious, and we have no intention of encouraging such debate by discussing each party's claim that the other should be sanctioned.

<sup>4</sup> Registration No. 599,737, issued June 10, 1992; Sections 8 and 15 affidavit accepted; renewed twice.

<sup>5</sup> Defendant also submitted with its notice of reliance a copy of the registration sought to be cancelled, and a copy of the application which has been opposed. These documents are automatically of record because they form part of the application and registration files. See Trademark Rule 2.122(b)(1).

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The parties have fully briefed the case,<sup>6</sup> and both were represented at an oral hearing held before the Board.

Plaintiff sells a wide variety of school and office products. Mark Davis, plaintiff's Vice President of Marketing, testified that company records showed that RAINBOW was first used as a trademark for tablets in 1916 by Westab, plaintiff's predecessor-in-interest. Mr. Davis also testified that, since he began working for plaintiff in 1979, RAINBOW has been used by plaintiff as a trademark for a 3x5 pocket tablet containing pages of different colors. Although plaintiff's registration depicts the mark in the somewhat stylized form shown above, the mark has been and is currently depicted on the tablets in plain block letters, with the word RAINBOW above the word TABLET.<sup>7</sup> The tablet is

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In addition, defendant submitted with its notice of reliance a copy of "Clubbin'! The Mini-Magazine for Members Only"; a computer printout of what is entitled "Graphic/Design Mentions" for 1994 and 1995; a computer printout of a paper headed "1994 Clubbin' Survey Results", and various fan letters. Plaintiff objected to these materials because they were neither printed publications nor official records within the meaning of Trademark Rule 2.122(e). Plaintiff's objection is well taken. Accordingly, these materials have not been considered as being of record pursuant to the notice of reliance. To the extent that these documents, or portions thereof, are admissible as part of Mr. Enos' testimony, they have been considered.

<sup>6</sup> With its brief defendant has submitted plaintiff's response to defendant's interrogatory No. 4. Plaintiff has objected. Because this response was not properly made of record by defendant during its testimony period, plaintiff's objection is well taken.

<sup>7</sup> Although plaintiff asserts in its brief and its reply brief that its mark has been used continuously for over 80 years, Mr. Davis' testimony is only that based on his familiarity with plaintiff's files, the mark "was in use originally in 1916, was a

marketed to home office and school consumers of all ages, although its tablet product line is marketed principally to children. The RAINBOW tablet is sold in such trade channels as drug stores, food stores, discount stores, college bookstores and office super stores. It is marketed throughout the United States. Plaintiff does not do direct advertising of the RAINBOW tablet, although it is listed and appears in plaintiff's annual School and Office Products Catalog and in sell sheets. These materials are used by plaintiff's salespeople to pre-sell plaintiff's products to retailers, and the catalogs may also be used by these retailers as a reference guide. Plaintiff also exhibits its entire product line, which would include the RAINBOW tablet, at trade shows.

Defendant sells stickers, stationery, writing instruments, party favors, activity products and seasonal products. Its primary target audience is girls aged six to fourteen. The products are sold in such retail stores as Wal-Mart, K-Mart and Toys-R-Us, and defendant advertises its goods, inter alia, on television and in consumer magazines such as "Barbie Magazine" and in trade publications.

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part of the property of Westab, and sometime in the early '70's was transferred to Mead as a result of the acquisition of Westab." p. 10. He also testified that plaintiff has used the RAINBOW mark for tablets since he started with the company in 1979. Plaintiff also made of record some invoices and catalogs showing use in 1967, 1977 and 1978.



Defendant's products are known as fashion items, in which the design is a key element of the product's appeal. Defendant's designs are part of what defendant refers to as "The Fantastic World of Lisa Frank," which is a fantasy world in which all defendant's characters live. In 1992 defendant began using a horse design for its products, and named this character RAINBOW CHASER. The character is supposed to be a high-spirited horse which is fast enough to chase a rainbow. Any items which are large enough to do so contain "biographical information" about the RAINBOW CHASER horse, e.g., "Rainbow Chaser is a pretty little Appaloosa filly who can run like the wind"; or "Rainbow Chaser has a special place she loves to visit that no one else knows about."

In 1993 defendant began using RAINBOW REEF in connection with its products having a design containing a seal pup and colorful fish and sea life. If space permits, defendant's RAINBOW REEF products contain a description showing that RAINBOW REEF refers to this habitat: "A secret playground lies deep in the hidden waters of Rainbow Reef." ...In fact everything in the reef is so colorful, the reflections are cast above the water, creating a rainbow that lights up the sky above the lagoon."

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We turn first to the question of priority. The evidence shows that plaintiff used its RAINBOW mark for writing tablets for many years prior to the October 26, 1992 filing date of defendant's application for RAINBOW CHASER, and the December 16, 1993 filing of the application which matured into a registration for RAINBOW REEF. Because both of these applications were based on intent-to-use, and because defendant has not proven an earlier use date, the filing dates are the earliest dates on which defendant may rely. Moreover, plaintiff has made its registration for RAINBOW and design of record, so that, in connection with the opposition proceeding, priority is not in issue. See **King Candy Co. v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

This brings us to the issue of likelihood of confusion. With respect to the goods, plaintiff's goods are "paper tablets," while defendant's goods identified in its RAINBOW REEF application are "stationery type portfolios, notebooks, writing tablets, memo pads, stationery and stickers" and the goods sought to be cancelled in defendant's registration for RAINBOW CHASER are "notebooks, folders, binders and stationery." Obviously, the writing tablets identified in defendant's RAINBOW REEF application are encompassed within the "writing tablets" listed in plaintiff's identification, while the other goods identified in defendant's application

and registration, and in particular "notebooks," are closely related to plaintiff's goods. Moreover, defendant's witness testified that its various goods are sold in grocery and drug stores and mass merchandisers; plaintiff's writing tablets are sold in the same trade channels.

We recognize that there are clear differences in the specific goods the parties sell, plaintiff's writing tablet being a non-fashion item bought for its utilitarian nature, while defendant's fashion products are purchased because the designs on them are the key element of their appeal. We further recognize that defendant's goods are designed to appeal to young girls, while plaintiff's goods would be purchased by adults as well as children, that is, plaintiff's customers are anyone needing a tablet with colored pages. However, we must determine the issue of likelihood of confusion on the basis of the goods recited in the respective registrations and application, rather than on what the evidence shows the goods to be. See **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed Cir. 1987). Thus, we must treat these goods as being identical or very closely related, and as being sold in the same channels of trade to the same classes of consumers.

Plaintiff's and defendant's goods are also very inexpensive. Plaintiff's tablets, and many of defendant's

products, sell for only a dollar or two. By their very nature they must be treated as impulse items which would not be purchased with great care.

These factors--the legal identity or closely related nature of the goods, the fact that they are sold in the same channels of trade to some of the same classes of purchasers, the inexpensive nature of the goods and the fact that they are sold to the general public, rather than discriminating purchasers--all favor plaintiff. Nevertheless, in view of the following factors which favor defendant, we find that confusion is not likely to occur from the contemporaneous use of the parties' marks.

Most importantly, the commercial impressions of the marks are different. Obviously, defendant's marks differ from plaintiff's in that they include the arbitrary words CHASER and REEF. These additional words give RAINBOW CHASER and RAINBOW REEF a different appearance and pronunciation from the word RAINBOW alone.

We do recognize that defendant's marks both begin with the word RAINBOW, which is the sole word in plaintiff's mark. However, this is not a situation where a defendant has appropriated a plaintiff's mark and merely added descriptive or subordinate matter to it. See **Miller Brewing Co. v. Premier Beverages, Inc.**, 210 USPQ 43, 49 (TTAB 1981), ("Here, although 'MILLER' forms a part of applicant's mark,

it is our view that, considered in its entirety, 'OL' BOB MILLER'S is readily distinguishable from 'MILLER' in every material respect and creates a commercial impression that is distinctive in its own right and would not be equated with or suggest 'MILLER' alone.")

RAINBOW is not the dominant portion of either RAINBOW CHASER or RAINBOW REEF. Rather, these terms will be viewed as unitary, with neither one word nor the other making a stronger impression on purchasers. Simply put, their commercial impression is that of the words together.

RAINBOW CHASER, taken literally, connotes someone or something that chases rainbows. The phrase "chasing rainbows" is also commonly used to refer to a dreamer, someone who is not practical.<sup>8</sup> As for RAINBOW REEF, it has the connotation of a place, such as a colorful coral reef or a reef with colorful sea life.<sup>9</sup>

On the other hand, plaintiff's mark RAINBOW, as applied to a tablet containing pages of different colors, indicates

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<sup>8</sup> See the following definition of "rainbow-chase": "A quest which is rendered pointless by the illusory nature of its object; hence rainbow-chaser, -chasing." The Oxford English Dictionary, 2d ed. © 1989. The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982, aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed Cir. 1983)).

<sup>9</sup> The record also reflects that, as the mark RAINBOW CHASER is actually used, it is always shown along with the prominent picture of a horse, and thus it will be viewed as the name of the horse. As for RAINBOW REEF, the connotation of a colorful reef is reinforced by the water and sea life picture which covers the products on which the mark is used.

that the tablet has multiple colors. In fact, one of the dictionary definitions for "rainbow" is "any brightly multicolored arrangement or display."<sup>10</sup> While we recognize that the identification of goods in plaintiff's pleaded registration is not limited to paper tablets containing pages of different colors, we note that if the mark were applied to plain white or single-colored paper tablets, the parties' marks per se still convey different connotations and hence different overall commercial impressions.

Moreover, these different connotations are reinforced by the trade dress of the items with which the marks are used. This Board and our primary reviewing Court have held that it is appropriate to consider the commercial impression created by the marks by looking to the manner in which they are used. See **Burns Philip Food Inc. v. Modern Products Inc.**, 24 USPQ2d 1157 (TTAB 1992), *aff'd unpub. opin.*, 28 USPQ2d 1687 (Fed. Cir. 1993); **Vornado Inc. v. Breuer Electric Mfg. Co.**, 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968 ("...the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression"); **In re Nationwide Industries, Inc.**, 6 USPQ2d 1882, 1883 (TTAB 1988) ("... evidence of the

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<sup>10</sup> The Random House Dictionary of the English Language, 2d ed., unabridged, © 1987.

context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project to purchasers"). See, also, **In re P. Ferrero & C.S.p.A.**, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973), in which the Court looked to the specimens showing applicant's checkerboard-colored ice cream to determine that the mark TIC TAC TOE was tied to the product and was not an arbitrary term.<sup>11</sup>

As indicated above, plaintiff's mark RAINBOW for a tablet containing pages of different colors is highly suggestive of the goods, and therefore it is not entitled to a broad scope of protection. Although plaintiff, through its predecessor-in-interest, began using the mark in 1916, and has provided evidence of continuous use since 1977, we cannot find that plaintiff has demonstrated that its mark has acquired strength either through sales or promotion. Plaintiff has submitted its sales figures under seal, so we cannot recite them here, but they fall far short of showing that its mark has become strong, let alone famous. Nor has plaintiff advertised its RAINBOW tablets in a fashion which would give consumers an awareness of the mark. The only

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<sup>11</sup> While we have looked to the products and trade dress to determine the commercial impressions created by the marks, we have not considered the facts, as urged by defendant, that defendant's products feature bright, vibrant colors, or that the parties use their house marks as well as their respective trademarks.

promotion that plaintiff does of its RAINBOW tablets is directed to retailers through its listing in plaintiff's annual catalog and its listing in sell sheets, where the item appears periodically.<sup>12</sup> In the annual product catalogs, the RAINBOW tablet is listed along with over 1,200 other products. Nor does it stand out in these hundreds of items. For example, while the RAINBOW POCKET TABLET is listed in Section 7 of the 22-section 1996 catalog, it is not pictured at the beginning of the section, although many of the other items which are featured in this section do appear. Even in the much smaller sell sheet which is of record, the RAINBOW tablet is only one of 42 items listed, and it is pictured in a fairly small size with a group of 22 memo books and papers in the inside of the 4-page 8½ x 11 brochure.

In short, plaintiff has provided no evidence of consumer recognition of its RAINBOW brand for tablets, nor

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<sup>12</sup> Mr. Davis' specific testimony on this subject, is as follows:

Q: Mr. Davis, what kind of advertising promotional activity, if any, does Mead conduct with respect to the Rainbow Tablet?

A: None directly to the Rainbow Tablet. We do incur, obviously, some cost in resetting schematics where this item is merchandised, and we do produce sell sheets, obviously, to support that item. But in terms of any print, trade or television advertising, we do not spend money to promote that item.

Davis, p. 23

It is unclear from the evidence of record what the schematics which Mr. Davis referred to are.



any evidence on which we could conclude that such recognition exists.

Plaintiff has argued that in the past it has used RAINBOW on fashion tablets and that, as a result, consumers, encountering RAINBOW CHASER or RAINBOW REEF on fashion tablets, are likely to believe that plaintiff "has renewed its use of RAINBOW on other fashion tablets." Brief, p. 16. Plaintiff specifically refers to its use of "SOPHISTICATS RAINBOW fashion tablets and MICKEY'S STUFF FOR KIDS RAINBOW DOODLE PAD", brief, p. 9. Plaintiff has not provided any examples of this usage, such that we can determine the commercial impression that it might have made on consumers. Certainly the listing in its annual catalog as MICKEY'S STUFF FOR KIDS® RAINBOW DOODLE PAD, immediately following MICKEY'S STUFF FOR KIDS® DRAWING PAD, gives the impression that RAINBOW is being used in a descriptive manner. The same is true of the listing in its Exhibit 12, its corporate price key pages, in which the product, a "memo pad containing 100 sheets of colored writing paper," is listed as "SOPHISTICATS™ RAINBOW PAD. Further, there is no evidence of the extent of the past sales of these fashion items which would support the position that consumers are familiar with the formerly sold items, would remember them, and would therefore assume that plaintiff's products and defendant's emanate from the same source.

Finally, we note that plaintiff at one time sold RAINBOW BRITE stationery under license from Hallmark. Because this use would inure to the benefit of Hallmark, we must assume that plaintiff did not regard Hallmark's rights in RAINBOW BRITE as infringing on plaintiff's rights in its RAINBOW mark. The fact that plaintiff did not find RAINBOW BRITE for stationery objectionable, and to the contrary endorsed such use by selling RAINBOW BRITE stationery under license, is further evidence that RAINBOW CHASER and RAINBOW REEF are not likely to cause confusion with RAINBOW, since these marks are even more different from RAINBOW than is RAINBOW BRITE.<sup>13</sup>

Decision: The opposition is dismissed, and the petition for partial cancellation is denied.

E. J. Seeherman

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<sup>13</sup> We would point out that our decision has not considered this evidence about the RAINBOW BRITE mark as favoring defendant in terms of traditional third-party use, i.e., as indicating that the public is so familiar with RAINBOW marks that it would look to other elements to distinguish the marks. Although plaintiff's use of RAINBOW BRITE under license would inure to the benefit of Hallmark, and thus must be treated as third-party use, defendant has not submitted any other evidence of third-party use. In this connection, we would point out that the introduction of a private company's search report does not make the registrations listed therein of record. Further, evidence of third-party registrations is not evidence of use of the marks shown in the registration. The single instance of third-party use is insufficient to demonstrate that the public is familiar with RAINBOW marks, and, moreover, the use of RAINBOW BRITE is not only not current, but we have no information as to the extent of the use when it did occur.

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